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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,223	11/30/2001	Brian Moran	005258.P003	9212

7590 10/06/2004

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EXAMINER

DAO, MINH D

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/000,223	Applicant(s) MORAN ET AL.	
	Examiner MINH D DAO	Art Unit 2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 26 is objected to because of the following informalities: claim 26 should depend on claim 25. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 13-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Knotts (US 6,658,260).

Regarding claim 13, Knotts teaches a method for rerouting a wireless message (see fig. 2) comprising: enabling a user to generate an original short messaging service (SMS) message on a sending wireless device and request the message be sent to a destination wireless device having a service provider that is different than that for the

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sending wireless device (see fig. 2, carriers 1-n; col. 5, lines 51-67); appending rerouting indicia to the original SMS message (col. 5, lines 51-67); sending the original SMS message to a shod messaging service center (SMSC) operated by a service provider for the sending wireless device (col. 5, lines 51-54); redirecting the original SMS message from the SMSC to a rerouting service identified by the rerouting indicia (col. 5, lines 51-67); determining a wireless access point for the destination wireless device (col. 5, lines 59-67); determining one or more service providers that provide infrastructure for routing messages to the wireless access point (col. 5, lines 51-67); generating a destination message based on content contained in the original SMS message (col. 5, lines 51-67); and dispatching the destination message to be delivered to the destination wireless device via message routing infrastructure provided by the one or more service providers (col. 5, lines 51-67). In this case, Inter-carrier Messaging Module together with the Carrier Routing Table reads on the routing infrastructure of the present invention.

Regarding claim 14, Knotts teaches the method of claim 13, wherein the destination device comprises a one of a cellular phone or pager having a phone number, and the user generates and sends the original SMS wireless message in a conventional matter by sending the message to the phone number of the destination wireless device (see fig. 6, col. 42-55).

Regarding claim 15, Knotts teaches the method of claim 13, wherein appending rerouting indicia to the original SMS message comprises appending an alphanumeric code to a phone number corresponding to the destination wireless device (see fig. 6, col. 42-55).

Regarding claim 16, Knotts teaches the method 15, wherein the alphanumeric code comprises an unused area code (col. 10, lines 30-34) as described in the specifications.

Regarding claim 17, Knotts teaches the method of claim 13, wherein the wireless access point comprises a phone number for the destination wireless device, and said one or more service providers are determined by querying one or more phone number-to-service provider databases operated by or accessible to the rerouting service using the phone number as a search criteria (see fig. 6; col. 10, lines 42-55).

Regarding claim 18, Knotts teaches the method of claim 13, further comprising: determining data handling capabilities of the destination wireless device; and generating the destination message such that it corresponds to the data handling capabilities of the destination wireless device (see fig. 6; col. 10, lines 42-55).

Regarding claim 19, it is inherently known in the art, for the purpose of tracking the user of the service, that the rerouting center of Knotts must be able to determine an identification of the sending wireless device; and recording transactional data

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corresponding to the rerouting of the wireless message so that the message rerouting service can bill an operator of the sending and/or destination wireless devices.

Regarding claim 20, Knotts teaches the method of claim 13, further comprising: determining any wireless messaging rules that are particular to the service providers that are used to route the destination message to the destination wireless device; and generating the destination message such that it corresponds to those wireless messaging rules (col. 10, lines 42-55).

Regarding claim 21, Knotts teaches the method of claim 13, wherein the destination device comprises one of a cellular phone or pager and the destination message comprises an SMS message that is routed to the destination device via a short messaging service center (SMSC) operated by a service provider for the destination device (see entire fig. 2).

Regarding claim 22, Knotts teaches the method of claim 13, wherein the destination device comprises an Internet-enabled wireless device (col. 5, lines 59-67) and the destination message comprises an instant message that is routed to an instant messaging service center that provides instant messaging services via an account held by a user of the destination wireless device (see figs 1 and 2, the Message Distribution Center (MDC), in this case, it is inherently known that the destination wireless device must

be a account holder of the messaging service center in order to receive messages from it).

Regarding claim 23, it inherently known in the art that any messaging service provider should always enables users to sign-up with the message rerouting service to have wireless messages they send or are sent by other rerouted to devices that they or others register with the message rerouting service for the benefit of gaining more customers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2, 24-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knotts (US 6,658,260) in view of Sladek et al. (US 6,718,178).

Regarding claim 1, Knotts teaches a method for rerouting a wireless message (see entire fig. 2) comprising: enabling a user to generate an original short messaging service (SMS) message on a sending wireless device and request the message be sent to a destination wireless device having a service provider that is different than that used for the sending wireless device (see fig. 2, carriers 1-n; col. 5, lines 51-67); determining a wireless access point for the destination wireless device (col. 5, lines 59-67); determining one or more service providers that provide infrastructure for routing messages to the wireless access point (col. 5, lines 51-67); generating a destination message from the content of the e-mail message (col. 10, lines 42-55); and dispatching the destination message to be delivered to the destination wireless device via message routing infrastructure provided by said one or more service providers (see fig. 6; col. 10, lines 20-29, lines 42-55). However, Knotts fails to teach automatically generating an e-mail message and sending the e-mail message to a message rerouting service. Sladek, in an analogous art, teaches automatically generating an e-mail message and sending the e-mail message (col. 15, lines 45-53; col. 15, lines 64-67; col. 16, lines 1-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to provide the teaching of Sladek to Knotts in order to reduce the message processing at the message rerouting center.

Regarding claim 2, the combination of the teachings of Knotts and Sladek teaches the method of claim 1, wherein the destination device comprises a one of a cellular phone or pager having a phone number, and the user generates and sends the original SMS wireless message in a conventional matter by sending the message to the phone number of the destination wireless device (Reference Knotts, see fig. 6, col. 42-55).

Regarding claim 3, the combination of the teachings of Knotts and Sladek teaches the method of claim 1, wherein automatically generating the e-mail message and sending it to the message rerouting service comprises: generating an e-mail address corresponding to a domain operated by the message rerouting service; adding text and/or data content from the original SMS message to an e-mail message; and sending the e-mail message to a simple mail transport protocol (SMTP) gateway operated by a service provider for the sending wireless device (Reference Knotts, col. 10, lines 20-64).

Regarding claim 4, the combination of the teachings of Knotts and Sladek teaches the method 3, wherein the e-mail address is generated by appending an e-mail domain address corresponding to the message rerouting service to the phone number of the destination wireless device (Reference Knotts, col. 10, lines 56-64).

Regarding claim 5, the combination of the teachings of Knotts and Sladek teaches the method of claim 1, wherein the wireless access point comprises a phone number for the destination wireless device, and said one or more service providers are determined by querying one or more phone number-to-service provider databases operated by or accessible to the rerouting service using the phone number as a search criteria (Reference Knotts, see fig. 1, MIN/CARRIER DATABASE; col. 10, lines 1-16).

Regarding claim 6, the combination of the teachings of Knotts and Sladek teaches the method of claim 1, further comprising: determining data handling capabilities of the destination wireless device; and generating the destination message such that it corresponds to the data handling capabilities of the destination wireless device (Reference Knotts, see fig. 6; col. 10, lines 42-55).

Regarding claim 7, the combination of the teachings of Knotts and Sladek teaches the method of claim 1, further comprising: determining an identification of the sending wireless device; and recording transactional data corresponding to the rerouting of the wireless message so that the message rerouting service can bill an operator of the sending and/or destination wireless devices (see rejection of claim 19, also see col. 7, lines 49-53 of Knotts).

Regarding claim 8, the claim has the same limitations as that of claim 20 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 20.

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Regarding claim 9, the claim has the same limitations as that of claim 14 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 14.

Regarding claim 10, the claim has the same limitations as that of claim 22 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 22.

Regarding claim 11, the claim has the same limitations as that of claim 23 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 23.

Regarding claims 12 and 24, the combination of the teachings of Knotts and Sladek teaches enabling the user to specify delivery preferences for the wireless message; and delivering the destination message to the destination wireless device based on the delivery preferences specified by the user (Reference Sladek, col. 9, lines 57-60).

Regarding claim 25, the claim has the same limitations as that of claim 1 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 1.

Regarding claim 26, the claim has the limitations as that of claim 1 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 1.

Regarding claim 27, the claim has the limitations as that of claim 3 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 3.

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Regarding claim 28, the claim has the limitations as that of claim 27 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 27.

Regarding claim 29, the combination of the teachings of Knotts and Sladek teaches The method of claim 27, wherein the rerouting service e-mail address comprises a prefix to which the domain is appended to, and the destination e-mail address may be derived from the prefix (reference Knotts, col. 11, lines 1-4).

Regarding claim 30, the claim has the limitations as that of claim 17 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 17.

Regarding claim 31, the claim has the limitations as that of claim 7 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 7.

Regarding claim 32, the claim has the limitations as that of claim 1 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 1.

Regarding claim 33, the claim has the limitations as that of claim 15 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 15.

Regarding claim 34, the claim has the limitations as that of claim 16 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 16.

Regarding claim 35, the claim has the limitations as that of claim 28 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 28.

Regarding claim 36, the claim has the limitations as that of claim 30 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 30.

Regarding claim 37, the claim has the limitations as that of claim 31 and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 31.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

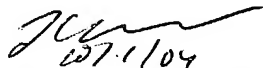
- a. Portman et al. (US 2004/0166832) discloses Directory Assistance With Multi-Modal Messaging.
- b. Lewis et al. (US 6,738,635) discloses Wireless Schedule Notification Method And System.
- c. Tunnidcliff (US 6,055,240) discloses Method And Apparatus For Message Mnagement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D DAO whose telephone number is 703-305-5589. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN C CHIN can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Minh Dao
Art Unit 2682
September 26, 2004 *md*


09/11/04
LESTER G. KINCAID
PRIMARY EXAMINER